07-25-07 AF/ZTW

IN THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Harold W. Milton, Jr.

Art Unit: 2627

Appl. No.: 09/273,021

Examiner: Sanjiv D. Shah

Filed: March 19, 1999

For: SYSTEM FOR FACILITATING THE PREPARATION OF A PATENT APPLICATION

Docket No.: MILT.777 (35322-00004)

Mail Stop Petitions
Commissioner of Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Applicant submits the following arguments in reply to the Examiner's Answer dated May 25, 2007.

CERTIFICATE OF EXPRESS MAIL

I hereby certify that this **Reply Brief** for U.S. Application No.: 09/273,021 is being deposited with the United States Postal Service as **Express Mail (Label No. EV 857774472 US)**, postage prepaid, in an envelope addressed to Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on **July 24, 2007** by the undersigned:

Susan K. Olson (Susan K. Olson)

I. STATUS OF CLAIMS

Claims 1, 3, 10, and 19-28 are pending in the application, with claims 1, 19, 20, 21, and 26 being independent. The full text of each claim rejected on prior art is reproduced in the Claims Appendix VIII to the Appeal Brief filed 21 March 2007.

II. GROUNDS OF REJECTION

Claims 1, 3, 10 and 19-28 are pending in the application. Claims 1, 19, 20, 21, and 26 are independent. Independent claims 1 and 26 and dependent claims 3, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as being obvious over Petruzzi et al. (U.S. Patent No. 6,049,811) in view of Rivette, et al. (U.S. Patent No. 5,754,840). Claims 10, 19, 20, 23, 24, 25, 27, and 28 are also rejected over Petruzzi in view of Rivette but further in view of Newman (U.S. Patent No. 5,774,833).

III. ARGUMENT

A. KSR

An alignment of the *KSR* decision with all of the previous Supreme Court decisions and an organization of the dicta in the *KSR* decision sets forth an alternative common sense selection (CSS) test (common sense was mentioned five times in KSR). The tests for obviousness which can be gleaned from *KSR* are:

1. a teaching, suggestion or motivation (TSM) in the prior art can still render an invention obvious,

2. the mere selection of elements from various prior art references and combining them together *with no new function or unpredictable result* is an obvious use of common sense by one skilled in the art, and, therefore, not patentable, and

3. a combination that includes something new or produces a new function or unpredictable result is presumed patentable absent cogent reasoning that is unequivocally independent of hindsight.

The subject invention is new and sets forth the new step of the assignment of reference numerals to element names, and, more specifically, the automatic re-order and re-assignment of the reference numerals in the description in the event of re-order of first recitation of the elements names in the description, i.e., so the reference numerals are first presented in numerical order. These steps are certainly new and are patentable because without applicant's teaching the references could not be modified as the examiner suggest. The examiner's reasoning is not unequivocally independent of hindsight.

B. RESPONSE TO EXAMINER'S ANSWER

It is necessary to point out errors in the examiner's interpretation of the Rivette, et al. '840 reference.

Rivette, et al. '840 teaches a method of preparing a patent application document wherein the element names are dependent on the reference numerals. In contradistinction, the subject invention claims a method of preparing a patent application document wherein the reference numerals are dependent on the element names, a completely new step. In other words, the subject claims are the direct opposite to Rivette, et al. '840. In Rivette, et al. '840 the element names are attached to the reference numerals whereas in the subject claims, the reference numerals are attached to the element names, i.e., the reverse.

1. Examiner's Interpretation of Rivette, et al. '840

The Examiner recognizes Rivette, et al. '840 teaches a method of correcting discrepancies in element names attached to a reference numeral in a patent application document. The Examiner states,

> Rivette teaches a method of allowing user to identify the reference numbers and modify the element name. Word processor locate reference number and text or element name can be inserted next to reference numbers as described in Col. 16, lines 47-52.

The applicant agrees. Rivette, et al. '840 does teach a method of determining an element name from a reference numeral. (See col. 15, lines 52-55). Rivette, et al. '840 teaches that the invention "assumes" that the element name or terms appearing immediately before the reference numeral comprise the element name corresponding to the reference numeral to be stored in the element index table. (See col. 15, lines 57-60). Rivette, et al. '840 also allows a user to modify the element names attached to reference numbers to manually reconcile any discrepancies. (See col. 16, lines 28-30). However, Applicant 's claims clearly distinguish.

2. Rivette, et al. '840 is Opposite to Claims

In contradistinction, the subject invention avoids discrepancies by automatically attaching reference numerals to element names as opposed to attaching the element names to reference numerals. Said another way, the subject invention assigns reference numerals to

specific element names to prevent a reference numeral from being used with inconsistent element names. The subject invention is opposite to the teachings of Rivette, et al. '840.

3. Rivette, et al. '840 Does Not Teach Reassigning Reference Numerals to Elements

The examiner further relies upon Rivette, et al. '840 to teach the claimed assignment and re-assignment of reference numerals to element names. The examiner states,

> Since the references numbers are identified and modified with element name, it would also shift the reference numerals if order of occurrence changes as claimed because element name is inserted next to reference numbers and since each occurrence of element is searched based on element number as described in col. 14, lines 60-Col. 15, lines 10. the sequence of elements may change or have changed. In such a situation, the reference numerals for a given element will automatically change.

The Applicant respectfully disagrees with this interpretation. Rivette, et al. '840 teaches a method wherein the element names are dependent on or attached to the reference numbers. (See col. 15, lines 52-Col. 16, lines 54). For example, in Rivette, et al. '840, if reference numerals are not manually inserted into the claims, the invention will recognize the patent application document as having zero element names in the claims. (See col. 15, lines 47-49). In other words, the invention will not recognize an element name without a reference numeral. Accordingly, the element names are identified and modified by the reference numerals. The reference numerals are not identified and attached to the element names as stated by the examiner.

Rivette, et al. '840 teaches a method wherein reference numerals are solely used to create an element index table, navigate through a patent application document to locate occurrences of the reference numeral, and edit the element name preceding the reference numeral. (See col. 14, lines 57-59 and Fig. 23). Therefore, since the reference numerals are used to locate the element names, changing the order of occurrence of the element names

cannot automatically shift the reference numerals as stated by the examiner because the reference numerals are in no way dependent on the element names.

Since Rivette, et al. '840 assign element names to reference numerals, there is no possibility of automatically re-assigning reference numerals to element names in the re-order of recitation in the description. Even the use of hindsight does not allow one to interpret Rivette, et al. '840 as teaching the assignment and reassignment of reference numerals to element names in the order of first recitation.

C. SUMMARY

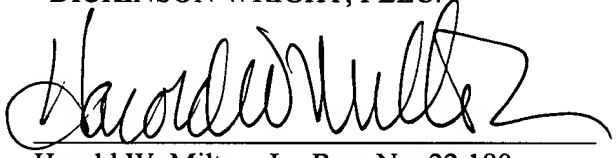
The U.S. Supreme Court, in *KSR* held that novelty is patentable absent cogent reasoning that is unequivocally independent of hindsight. The claims in issue here set forth new steps that are patentable as the only path to obviousness from Rivette, et al. '840 is through applicant's teachings, i.e., hindsight.

The route to obviousness must be a flagstone path, plainly perceptible in either the light or the dark. The examiner's path is tortuous and laid of the chips from the prior art in pursuit of applicant's teachings.

For these reasons, the reversal of the rejection of all of the claims is respectfully solicited.

Respectfully submitted,

DICKINSON WRIGHT, PLLC.



Date: July 24, 2007

Harold W. Milton, Jr., Reg. No. 22,180
Attorney for Applicant

38525 Woodward Ave., Ste. 2000
Bloomfield Hills, MI 48304-5092
Tel. (248) 433-7385